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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,862	10/21/2005	Koji Tsuchida	3273-0215PUS1	6571
2292 7590 04/30/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
DICUS, TAMRA				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
04/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/553,862

Applicant(s)

TSUCHIDA ET AL.

Examiner

TAMRA L. DICUS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

The RCE is acknowledged.

The 102b rejection is withdrawn, the 103 rejection adjusted below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,186,782 to Freedman in view of US 6,749,936 to Argoitia et al.

Freedman teaches a multilayer label having a core surrounded by skin layers, where the when an opaque film layer is required, calcium carbonate, titanium dioxide, and blends are used in the core and skin layers (5:20-68) along with resins such as EVA, polyethylene or polystyrene (2:10-50, 6:5-20, same material as Applicant, see Ex. 18 and performs the same stretching under heat with extrudates (6:55-68, 7:1-68) as in Applicant's Ex. 1 (pg. 27, lines 10-15) where the film is stretched in a lengthwise direction to yield a heat shrinkable film and thus the film of Freedman is considered to function as

heat-shrinkable) that are adhered to plastic bottles or other flexible articles (4:50-55, embraces container).

Freedman does not teach the volume percentage as claimed, however, volume relates to the size and is obvious to adjust and modify. It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284. Size of an article ordinarily is not a matter of invention. The size relating to volume recitations of each layer are all deemed matters of choice involving differences in degree and/or size and are not patentable distinctions. *In re Rose*, 105 USPQ 237.

Freedman does not expressly teach the recited properties of transparency, transmission or W-value, however, because the same colors and materials are employed, the resultant properties are presumed inherently present.

Alternatively, if not inherent, then it would have been obvious to one having ordinary skill in the art to have modified the amount of colors to produce the desired properties because Freedman teaches the colors produce opaque films, and thus effects the opacity of the label as cited above. Additionally, what happens when something else happens, e.g. when the film is immersed in hot water, is not a positive recitation.

Further to claim 1, how the film is prepared is represents process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product appear to be chemically and structurally the same.

Freedman does not teach using achromatic colors or the transparency, transmission or W-value properties per instant claims 1 and 4 or an ink layer (per claim 7), while teaching applications to bottle containers (claim 8).

Argoitia teaches achromatic multilayer pigments used in ink, paint, or moldable plastic material with resins such as styrenes (21:1-30) and combined with pigments (chromatic) TiO₂ to produce unique color effects and with carbon black, blue or aluminum to control lightness and other color properties used as inks for printing on packaging, containers, or used to form colored plastic materials, extruded parts and laminating films (21:50-68, 22:1-36).

It would have been obvious to one having ordinary skill in the art to have modified the article of Freedman to include achromatic or chromatic color in any layer and printed with ink because Argoitia teaches advantages such as unique color effects lightness control, and making an article decorative used in packaging or containers as cited above.

Claims 9-13, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,186,782 to Freedman in view of US 6,749,936 to Argoitia et al. as applied to claims 1, 4, and 7-8, and further in view of WO 99/61245 (Bergholts et al.).

It is noted that when utilizing WO 99/61245 in the above paragraph, the disclosures of the reference are based on US 6,866,907 which is an English language equivalent of the reference. Therefore, the column and line numbers cited with respect to WO 99/61245 are found in US 6,866,907.

The combination does not teach the percentages of white and black colorants as claimed (claims 9-13 and 16-20).

Bergholts teaches a packaging material of similar shrinkable polyethylene coextruded material and structure wherein the core and outer skin layers may comprise 3-80% white particles, TiO₂ in 5% or less, and black colorant carbon black from 0.04-1%, which all fall in Applicant's recited ranges. See 3:1-60, 4:20-55, 5:1-45. Such additions make the overall film for bottles have a consumer-attractive white appearance despite the presence of carbon black in the packaging material. See also patented claims 1-9.

It would have been obvious to one having ordinary skill in the art to have modified the combination in view of the colorant percentages as claimed because Bergholts teaches such ranges have a consumer-attractive white appearance despite the presence of carbon black in the packaging material as cited above. Further it would have been obvious to one having ordinary skill in

the art to have modified the colors to include any color, including yellow or brown, due to aesthetics. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness “from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the Freedman reference (nor any others applied) teaches heat setting or sealing but not heat shrinkable opaque white film. However, this argument is not convincing because the same materials and weight ranges are provided by the prior art as set forth above, and thus because the same material is provided, it is expected to function and act as “heat shrinkable”, absent any evidence to the contrary. It is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the

prior art.” *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Freedman reference teaches all of Applicant’s claimed compositional and positional limitations, it is inherent or expected that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430.

To all other arguments of what would or could happen, they are deemed speculative and not proven. The combination would not be inoperable because while the combination may have a different result, the Applicant has not shown it won’t work at all. It is unnecessary, however, that inventions of references be physically combinable to render obvious an applicant’s invention. *In re Sneed*, 710 F.2d 1544, 1550, 218. The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference, but what the combined teachings of those references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208. A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective

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evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

April 23, 2009

/Bruce H Hess/
Primary Examiner, Art Unit 1794